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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,647	11/07/2001	Bernd Mayer	IN-5505	7382

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1714

9

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,647

Applicant(s)

MAYER ET AL.

Examiner

Patrick D. Niland

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**THE MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Reply**

EXTENDED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
MAILING DATE OF THIS COMMUNICATION.

Periods of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
X (6) MONTHS from the mailing date of this communication.
Period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
Period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
A reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
patent term adjustment. See 37 CFR 1.704(b).

Responsive to communication(s) filed on 11 October 2002.

This action is **FINAL**.

2b) ☐ This action is non-final.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) 1 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2-13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction and/or election requirement.

Specification Papers

☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 5 & 7.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

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1. The amendment of 10/11/02 has been entered. Claims 1-13 are pending.
2. Newly submitted claim 1 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
 - a. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1, drawn to a system of at least four components for a cotaing composition, classified in class 524, subclass 906.
 - II. Claims 2-13, drawn to coating compositions, method of making coating compositions, and coated articles therefrom, classified in class 524, subclass 589.
 - b. The inventions are distinct, each from the other because:

Inventions of group I and group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as components for other compompositions, for example I can be used as binder in another curing mechanism, such as transesterification or transamidation, II can be used to cure resins which are different than I, III, or IV such as a solventless, dispersantless molding resin with NCO active groups, III can be used to water a lawn, and IV can be used as acrylic paint by itself and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit

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evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

c. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 1 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Claims 2-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims 3, 4, 5, 6, 7, 8, 9, 10 depend from claim 1 ultimately. These claims are directed towards "coating compositions" whereas claim 1 is directed towards a "system of at least four components for a coating composition". The claim dependency makes it unclear as to whether the instant claims 3-9 require the claimed components to be in mixed or unmixed form.

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B. The instant claims 11-13 refer to the "coating composition of claim 1". Claim 1 is directed towards a "system of at least four components for a coating composition". It is therefore unclear to what coating composition claims 11-13 refer.

C. The instantly claimed component III requires the water to be substantially free of acrylate copolymers. However, acrylate copolymers may be one of the composition ingredients and the instant claims are directed to the composition which is a mixture of the claimed ingredients. It is therefore unclear how or if "substantially free from acrylate copolymers" limits the instant claims. This continues to be unclear in claims 2-13.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-13 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/42247

Lettmann et al. as interpreted by US Pat. No. 6025031 Lettmann et al..

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Lettmann et al. discloses the instantly claimed coating composition, methods of making the composition, and coatings made therefrom. See the entire document. As stated above, it is not seen that the recitation excluding acrylate copolymer of component III distinguishes over the prior art since a composition is claimed and the composition requires acrylate copolymer. It is further expected that at some point the water of the prior art did not contain acrylate copolymer.

Reference to the instant claim 1 is not persuasive since the rejected claims are directed to coating compositions and coatings made therewith. It is therefore the examiner's position that the components are mixed together in the instantly claimed coating compositions. The prior art therefore continues to read on these claims. Also, as previously stated, the water is expected to have existed without polyacrylate at some point in the processing. Therefore claim 2 continues to be encompassed by the prior art.

7. Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/42247 Lettmann et al. as interpreted by US Pat. No. 6025031 Lettmann et al..

Lettmann et al. discloses the instantly claimed coating composition, methods of making the composition, and coatings made therefrom. See the entire document. As stated above, it is not seen that the recitation excluding acrylate copolymer of component III distinguishes over the prior art since a composition is claimed and the composition requires acrylate copolymer. It is further expected that at some point the water of the prior art did not contain acrylate copolymer. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients in the compositions, methods of making, and

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coatings of Lettmann et al. because they are encompassed by the prior art and would have been expected to give compositions having the properties disclosed by Lettmann et al.. Reference to the instant claim 1 is not persuasive since the rejected claims are directed to coating compositions and coatings made therewith. It is therefore the examiner's position that the components are mixed together in the instantly claimed coating compositions. The prior art therefore continues to read on these claims. Also, as previously stated, the water is expected to have existed without polyacrylate at some point in the processing. Therefore claim 2 continues to be encompassed by the prior art.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

January 26, 2003


Patrick Niland
Primary Examiner
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